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22895	7590	02/27/2006	EXAMINER	
PATRICK J S INOUE P S			SCHUBERT, KEVIN R	
810 3RD AVENUE			ART UNIT	
SUITE 258			PAPER NUMBER	
SEATTLE, WA 98104			2137	

DATE MAILED: 02/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,493

Applicant(s)

SEARLE, SCOTT

Examiner

Kevin Schubert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/7/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/1/02 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09102002; 09302002.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: IDS: 02212003.

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DETAILED ACTION

Claims 1 and 5 have been considered.

Election/Restrictions

5 Claims 2-4 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/7/05.

Claim Rejections - 35 USC § 112

10 The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15

 Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to
20 make and/or use the invention. More specifically, the phrase "the credit card information being stored in textual form" in part b appears to not be enabled. It is well known in the art that a computing device stores information in binary form. Examiner fails to understand how information in the claimed invention is stored in textual form. Appropriate correction is required.

25 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

30 Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Applicant claims that an image is placed "in the corner of the video". The phrase is unclear. Examiner believes the phrase "in a corner of the video" may be more appropriate. Appropriate correction is required.

- 5 Claim 5 recites the limitation "the first or second personal information". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

10 The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

15 (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Holmes, U.S. Patent No. 6,119,108.

25 As per claims 1 and 5, the applicant describes a method of displaying a semi-transparent graphical overlay in the corner of a video comprising the following limitations which are met by Holmes:

a) retrieving a user's credit card information and an electronic video file containing data representative of frames in a video (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23; Col 6, line 39);

30 b) combining the data contained in the electronic video file with the credit card information to create a new file, the new file separating the video data from the credit card information, the credit card information being stored in textual form (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23);

c) encrypting at least the video data (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23);

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d) sending the new file from a server to a client (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23);

e) decrypting, at the client, the video data stored in the new file (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23);

5 f) rendering, at the client, the video from the video data stored in the new file, the step of rendering including placing a semi-transparent image in the corner of the video whereby the image displays the credit card information (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23);

g) displaying the rendered video including the semi-transparent image (Col 3, lines 30-40; Col 5, line 45 to Col 6, line 23).

10

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

15

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20

Claims 1 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komoda, Japanese Patent Number JP409065276A, in view of Ito, U.S. Patent Application No. 2001/0021979, in further view of Lipton, U.S. Patent Application Publication No. 2002/0009198, in further view of Foster, U.S. Patent No. 6,643,386.

25

As per claims 1 and 5, the applicant describes a method of displaying a semi-transparent graphical overlay in the corner of a video comprising the following limitations which are met by Komoda, Ito, Lipton, and Foster:

a) retrieving a user's credit card information and an electronic video file containing data
30 representative of frames in a video (Komoda: [0019], Fig 3; Ito: [0178]-[0183]);

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b) combining the data contained in the electronic video file with the credit card information to create a new file, the new file separating the video data from the credit card information, the credit card information being stored in textual form (Komoda: [0019], Fig 3; Ito: [0178]-[0183]);

c) encrypting at least the video data (Lipton: [0057]);

5 d) sending the new file from a server to a client (Lipton: [0057]);

e) decrypting, at the client, the video data stored in the new file (Lipton: [0057]);

f) rendering, at the client, the video from the video data stored in the new file, the step of rendering including placing a semi-transparent image in the corner of the video whereby the image displays the credit card information (Komoda: [0019]; Fig 3; Ito: [0178]-[0183]; Foster: Col 3 (lines 1-9);

10 g) displaying the rendered video including the semi-transparent image (Komoda: [0019]; Fig 3);

Komoda discloses a copy protection method in which a form of user identification and a video file are retrieved and combined to create a new file. The new file may be sent to another computing device. Upon display of the illegally copied video, the user identification is displayed in the corner of the video.

15 Komoda is silent as to the form of user identification being credit card information. Ito discloses the well-known idea that credit card information is a form of identification. Combining the ideas of Ito with those of Komoda allows the form of user identification to be credit card information. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Ito with those of Komoda because credit card information is a form of user identification which can be used to identify a user.

20 Komoda in view of Ito are silent as to the video data being encrypted. Lipton discloses the well-known idea that video data may be encrypted when it is sent between a server and a client. Combining the ideas of Lipton with those of Komoda allows video data to be encrypted when sent from a server to a client. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Lipton with those of Komoda in view of Ito and incorporate the use of encrypting
25 data between a server and client because doing so enhances security and data protection in the system.

Komoda in view of Ito in further view of Lipton do not disclose that an image placed in the corner of the video is **semi-transparent**. While the combination discloses that an image is placed in the corner

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of the video, the combination is silent as to the image being, specifically, semi-transparent. Foster discloses the idea that an image may be designed to be semi-transparent. It would have been obvious to one of ordinary skill in the art at the time the invention was filed to combine the ideas of Foster with those of Komoda in view of Ito in further view Lipton because designing the image to be semi-transparent is an efficient way to detract an illegal user from enjoyment of a video.

Conclusion

This action is made non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Schubert whose telephone number is (571) 272-4239. The examiner can normally be reached on M-F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KS


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER